UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/772,541 | 01/29/2001 | Robert M. Caruso | 6909-5 | 9250 |

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| EXAMINER |
|---|
| JEAN GILLES, JUDE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2143 | |

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/772,541 | CARUSO ET AL. |
| | **Examiner** | **Art Unit** | |
| | Jude J. Jean-Gilles | 2143 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>29 January 2001</u>.

2a)☐ This action is **FINAL**.　　　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-50</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-48</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) <u>49 and 50</u> are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 January 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

# DETAILED ACTION

This office action is responsive to communication filed on 01/29/2001. Claimed priority

is granted from provisional application with a priority No: 01/27/2000.

## *Election / Restriction*

1.      During a telephone conversation with Applicant's Representative, Ariel Rogson

on 08/29/2005, a provisional election was made to prosecute the invention of the rich

media file format and delivery methods, **claims 1-48.** Note that claims 49-50 do not

mention at all the rich media file and would require a separate search from the Office.

Affirmation of this election must be made by applicant in replying to this Office action.

**Claims 49-50** are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

## *Claim Rejections - 35 USC § 102*

2.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-7, 9-10, 12, and 42-47** are rejected under 35 U.S.C. 102(e) as being

anticipated by Leonard et al. (Leonard), Patent No. 6,721,784 B1.

Regarding **claim 1**, Leonard discloses a rich media file stored in a machine-readable medium (fig. 6, item 2), comprising:

information to be displayed on a computer system (column 18, lines 51-67; column 19, lines 1-15); and

a viewer desired to display the information on the computer system,

the information and the viewer contained in a single file (column 9, lines 23-30; column 14, lines 40-67).

Regarding **claim 2**, Leonard discloses a rich media file according to claim 1, further comprising limit means for limiting viewing of the rich media file (column 14, lines 40-67; column 15; lines 1-61).

Regarding **claim 3**, Leonard discloses a rich media file according to claim 2, wherein the limit means is selected from a setting defining a predetermined number of viewings of the information, a setting defining a predetermined number of days, a predetermined expiration date, and a password controlling access to the rich media file (column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 4**, Leonard discloses a rich media file according to claim 2, wherein limit means is designed to expire the rich media tile, and rich media file is designed so that it cannot be viewed after the rich media file has expired (column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 5**, Leonard discloses a rich media file according to claim 1, further comprising checking means for checking if there is a later version of the rich media file (column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 6**, Leonard discloses a rich media file according to claim 1, further comprising a query asking a user if the user would like to retrieve a later version of the rich media file (column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 7**, Leonard discloses a rich media file according to claim 1, further comprising retrieval means for retrieving a later version of the rich media file (column 13, lines 32-55; column 12, lines 51-67).

Regarding **claim 9**, Leonard discloses a rich media file according to claim 1, the rich media file further comprising a unique file identification in addition to a file name (column 10, lines 56-67).

Regarding **claim 10**, Leonard discloses a rich media file according to claim 1, wherein the information is formatted into a plurality of pages (column 16, lines 27-54).

Regarding **claim 12**, Leonard discloses a rich media file according to claim 1, wherein the viewer includes only a capability desired by a builder of the rich media file (column14, lines 41-67).

Regarding **claim 42**, Leonard discloses a memory for storing a platform-independent rich media file including a data structure stored in said memory, comprising:

information for the rich media file (column 18, lines 51-67; column 19, lines 1-15);

a unique identification for the rich media file (column 10, lines 56-67);

a version number for the rich media tile (column 13, lines 32-55; column 12, lines 51-67); and

at least one viewing option for the rich media file (column 9, lines 23-30; column 14,lines 40-67).

Regarding **claim 43**, Leonard discloses a memory according to claim 42, wherein the data structure further includes a client identification for a client creating the rich media file (column 10, lines 56-67).

Regarding **claim 44**, Leonard discloses a memory according to claim 42, wherein the data structure further includes expiration features (column 16, lines 12-26; column 17, lines 32-56).

Regarding **claim 45**, Leonard discloses a memory according to claim 42, wherein the data structure further includes a viewer for displaying the information (column 9, lines 23-30; column 14,lines 40-67).

Regarding **claim 46**, Leonard discloses a memory for storing a database of rich media files including a data structure stored in said memory, comprising:

a rich media file (column 18, lines 51-67; column 19, lines 1-15);

a profile of a user who downloaded the lich media file (column 12, lines 50-67);

a client who generated the rich media file (column 14, lines 1-67); and

a log storing a transaction in the data structure (column 12, lines 50-67).

Regarding **claim 47**, Leonard discloses a memory according to claim 46, the data structure further including a mapping from the rich media file to the client (column 14, lines 40-67).

## Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 8, 11, 13-41, and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard in view of Kelley (Kelly), U.S. Patent No: 6,078,921.

**Regarding claim 8**, Leonard teaches the invention substantially as claimed. Leonard teaches the rich text file of claim 1, but does not specifically teach a rich media file wherein the information is compressed using a compression technique to reduce the size of the rich media file.

In the same field of endeavor, Kelly discloses "...a combined single file referred to as a result field that can be compressed or uncompressed..[see Kelly, column 6, lines 39-62].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Kelly's teachings of a technique to compressed a rich text field, with the teachings of Leonard, for the purpose of "*allowing control of viewing and handling of the electronic field message and allowing the user to view the message using the applet viewer...*" as stated by Leonard in lines 51-55 of column 14. By this rationale **claim 8** is rejected.

The same motivation used for claim 8 is also valid for **claims 11, 13-41, and 48**

**below** [see Leonard, column 51-55, lines 14].

Regarding **claim 11**, the combination of Leonard-Kelly discloses a rich media file

according to claim 10, wherein the information includes a link from a first page of

the information to a second page of the information [see Kelly, column 8, lines

24-64].

**Regarding claim 13,** the combination of Leonard-Kelly discloses a rich media file

stored in a machine-readable medium, comprising:

information to be displayed on a computer system, the information compressed using

a compression technique [see Kelly; column 6, lines 39-62];

a viewer designed to display the information on the computer system [see Leonard;

column 9, lines 23-30; column 14,lines 40-67];

limit means for limiting viewing of the rich media file, the limit means drawn from a

setting defining a predetermined number of viewings of the information, a setting

defining a predetermined number of days, a predetermined expiration date, and a

password controlling access to the rich media file [see Leonard; column 16, lines 12-26;

column 17, lines 32-56];

checking means for checking if there is a later version of the rich media file [see

Leonard; column 13, lines 32-55; column 12, lines 51-67];

a query asking a user if the user would like to retrieve the later version of the rich

media file [see Leonard; ];

retrieval means for retrieving the later version of the rich media file [see Leonard; ]; and

a unique file identification for the lich media file in addition to a file name [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 14**, the combination of Leonard-Kelly discloses a method for retrieving a lich media file, the method comprising:

selecting a link on a network [see Kelly; column 6, lines 23-63];

downloading the rich media tile over the network based on a unique file identification other than the link and other than a tile name [see Leonard; column 10, lines 56-67]; and

saving the rich media file on a computer system [see Leonard; column 18, lines 51-67}.

Regarding **claim 15**, the combination of Leonard-Kelly discloses a method according to claim 14, wherein selecting a link includes transmitting the unique file identification over the network [see Leonard; column 10, lines 56-67].

Regarding **claim 16**, the combination of Leonard-Kelly discloses a method according to claim 14, wherein downloading the rich media file over the network from a remote server includes downloading the rich media file over the network from a remote server different from a second server that includes the link [see Kelly; fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 17**, the combination of Leonard-Kelly discloses a method according to claim 14, wherein downloading the rich media file includes downloading an earlier version of the rich media file [see Kelly; fig. 1, item 126; column 6, lines 24-62]..

Regarding **claim 18**, the combination of Leonard-Kelly discloses a method according to claim 14, the method further comprising opening the rich media file using a viewer built into the rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 19**, the combination of Leonard-Kelly discloses a method according to claim 18, wherein opening the rich media file includes checking to see if a later version of the rich media file is available over the network [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 20**, the combination of Leonard-Kelly discloses a method according to claim 19, wherein checking to see if a later version of the rich media file is available includes;

asking a user whether the later version of the rich media file is desired; and

if the user requests the later version of the rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67];

downloading the later version rich media file [see Leonard; column 13, lines 32-55; column 12, lines 51-67]; and

opening the later version of the rich media file using a viewer built into the

later version of the rich media file[see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 21**, the combination of Leonard-Kelly discloses a method according to claim 18, wherein opening the rich media file includes:

checking to see if the lich media file has expired [see Leonard; column 16, lines 12-26; column 17, lines 32-56]; and

if the rich media file has expired, asking the user if a later version of the rich media

file or chained file is desired [see Leonard; column 16, lines 12-26; column 17, lines 32-

56].

Regarding **claim 22**, the combination of Leonard-Kelly discloses a method according to

claim 21, wherein checking to see if the rich media file has expired includes refusing to

open the lich media file if the rich media file has expired [see Leonard; column 16, lines

12-26; column 17, lines 32-56].

Regarding **claim 23**, the combination of Leonard-Kelly discloses a method according to

claim 18, wherein opening the rich media file includes:

prompting for a password; and refusing to open the rich media file if the password is not

provided [see Leonard; column 16, lines 12-43].

Regarding **claim 24**, the combination of Leonard-Kelly discloses a method according to

claim 14, the method further comprising deleting the rich media file, thereby leaving no

footprint on the computer system [see Leonard, column 18, lines 34-65; see Kelly,

column 7, lines 16-30].

Regarding **claim 25**, the combination of Leonard-Kelly discloses a computer-readable

medium containing a program to retrieve a rich media file, the program being

executable on computer system to implement the method of claim 14 [see Leonard;

column 13, lines 32-55; column 12, lines 51-67];

Regarding **claim 26**, the combination of Leonard-Kelly discloses a method for building a

unitary lich media file, the method comprising:

assembling information for the unitary rich media file [see Leonard; column 17, lines 18-56];

formatting the information [see Leonard; column 17, lines 18-56];

coupling the information with a viewer [see Leonard; column 9, lines 23-30; column 14,lines 40-67]; and

converting the information and the viewer to the unitary rich media file [see Leonard; column 9, lines 23-30; column 14,lines 40-67], so that the unitary rich media file is designed to leave no footprint on a user's system when removed [see Kelly, column 7, lines 16-30].

Regarding **claim 27**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes placing the information on a plurality of pages [see Leonard; column 16, lines 27-54].

Regarding **claim 28**, the combination of Leonard-Kelly discloses a method according to claim 27, wherein formatting the information further includes placing a link on a first page of the information to a second page of the information [see Kelly, column 8, lines 24-64].

Regarding **claim 29**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes selecting viewing options to include with the rich media file [see Leonard; column14, lines 41-67].

Regarding **claim 30**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes assigning expiration parameters to the rich media file [see Leonard; column 16, lines 12-26; column 17, lines 32-56].

Regarding **claim 31**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein formatting the information includes placing the information into a platform-independent intermediary state [see Kelly; column 16, lines 12-54; column 18, lines 34-65].

Regarding **claim 32**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein coupling the information with a viewer includes coupling the information with the viewer for a particular computer platform [see Kelly; column 16, lines 12-54; column 18, lines 34-65].

Regarding **claim 33**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein converting the information includes formatting the information from an intermediate file format to a format for display in the rich media file, the format for display designed to work with the viewer on a particular platform [see Kelly; column 16, lines 12-54; column 18, lines 34-65].

Regarding **claim 34**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein converting the information includes compressing an image in the information [see Leonard; column 9, lines 23-30; column 14,lines 40-67];

Regarding **claim 35**, the combination of Leonard-Kelly discloses a method according to claim 26, wherein converting the information includes converting the information to the rich media file at a server not owned by a client building the rich media file [see Kelly; fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 36**, the combination of Leonard-Kelly discloses a method according to claim 26, the method further comprising:

storing the rich media file on a server [see Kelly; fig. 1, item 126; column 6, lines 24-62]; and

placing a link to the rich media file on a web page over a computer network [see Leonard; column 6, lines 43-60].

Regarding **claim 37**, the combination of Leonard-Kelly discloses a method according to claim 36, wherein storing the rich media file includes assigning the rich media file a unique file identification in addition to a file name [see Leonard; column 10, lines 56-67].

Regarding **claim 38**, the combination of Leonard-Kelly discloses a method according to claim 37, wherein placing a link includes using the unique file identification in the link [see Kelly, column 8, lines 24-64].

Regarding **claim 39**, the combination of Leonard-Kelly discloses a method according to claim 36, wherein storing the rich media file includes storing the rich media file on a server different from the one storing the link [see Kelly; fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 40**, the combination of Leonard-Kelly discloses a method according to claim 36, wherein storing the rich media file includes retaining an earlier version of the rich media file on the server [see Kelly; fig. 1, item 126; column 6, lines 24-62].

Regarding **claim 41**, the combination of Leonard-Kelly discloses a computer-readable medium containing a program to retrieving a lich media file, the program being executable on a computer system to implement the method of claim 26 [see Leonard; column 13, lines 32-55; column 12, lines 51-67].

Regarding **claim 48**, the combination of Leonard-Kelly discloses a memory according to

claim 46, the data structure further including an auto-notification for the user when the

rich media file is updated [see Kelly; column 8, lines 24-67; column 9, lines 1-7].


### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from examiner

should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914.

The examiner can normally be reached on Monday-Thursday and every other Friday

from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for

the organization where this application or proceeding is assigned is (703) 305-3719.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

3900.


Jude Jean-Gilles

Patent Examiner

Art Unit 2143


JJG

August 30, 2005
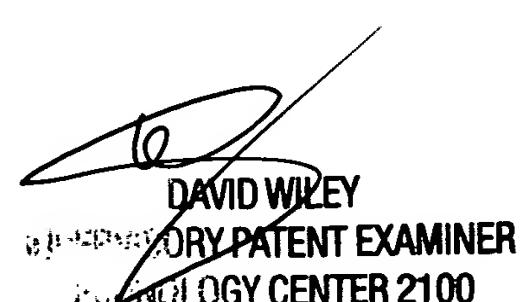
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